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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,759	12/30/2003	Nathaniel Blake Scholl	026014-002300US	2699

20350 7590 06/01/2009

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EXAMINER	
RETTA, YEHDEGA	

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
06/01/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/748,759	SCHOLL ET AL.	
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,6-14,16-21 and 35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,6-14,16-21 and 35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/3/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This office action is responsive to the Request for Continued Examination filed April 03, 2009. Applicant amended claims 1, 9 and 35. Claims 1, 2, 4, 6-14, 16-21 and 35 are currently pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 4, 6-14, 16-21 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 now recites a plurality of advertisement generators each operable to automatically generate an advertisement set for the advertiser and the at least one keyword, *each advertisement generator including a first algorithm for identifying search terms corresponding to an item to be advertised, a second algorithm for determining at least one creative aspect of an advertisement being created for the item, and a third algorithm for creating a link to information about the item,* each generated advertisement set including at least one different advertisement created using the determined creative aspect, the link to information about the item, and at least one search term matching the at least one keyword.

The specification teaches as follow:

> The bid calculator may also use different algorithms for different categories of advertisements. For example, an advertiser may use an algorithm that will maximize the profit for established product lines, and a different algorithm that will maximize sales for new product lines. The advertisement manager may determine whether an advertisement set has already been submitted for the search terms of the advertisement set. [0020]
>
> One skilled in the art will appreciate that various algorithms may be used to determine the bid amount, such as a minimum-bid algorithm, a fixed-bid algorithm, a profit-based algorithm, and a revenue-based algorithm.[0029]

However when it comes to advertisement generators the specification teaches as follows:

> A method and system for identifying advertisement and search term combinations for placing advertisements along with search results is provided. In one embodiment, the advertisement system includes multiple advertisement generators that automatically create advertisement sets that each contain one or more advertisements, one or more search terms, and a link to each advertised item. The different advertisement generators may use different algorithms to automatically generate (or "create") advertisements (also referred to as the "creative"), identify search terms, and create links to form advertisement sets. [0016]
>
> Keywords may be derived using various Information Retrieval techniques based on word frequencies, clustering algorithms that identify related keywords, and so on. One skilled in the art will appreciate that the advertisement system can be used to generate and place advertisements with an advertisement placement service (e.g., a search engine service) for use in the contexts, such as while content is being streamed to a client, on a web page through which a product can be purchased, and so on. [0017]
>
> FIG. 1 is a block diagram illustrating components of the advertisement system in one embodiment. The advertisement system 100 includes advertisement generators 101, an advertisement manager 102, a work manager 103, and advertisement submitters 104. Each advertisement generator generates advertisement sets based on a computer algorithm and then provides the advertisement sets to the advertisement manager. Each advertisement set includes an advertisement, one or more search terms, and a link (e.g., a uniform resource locator). [0019]

As indicated above the specification teaches *different advertisement generators* may use different algorithms to automatically generate (or "create") advertisements (also referred to as

the "creative"), identify search terms and create links to from advertisements. However, the specification does not teaches "***each advertisement generator*** including *a first algorithm for identifying search terms* corresponding to an item to be advertised, *a second algorithm for determining at least one creative aspect* of an advertisement being created for the item, and a *third algorithm for creating a link* to information about the item. In other words, the specification does not teach each generator uses three different algorithms to create the advertisement set. Also the specification teach generating (or "create") advertisements (also referred to as the "creative"), however does not teach that the generator uses algorithm for determining ***creative aspect***.

Claim 9 also recites algorithm specifying at least one creative aspect of at least one advertisement generated by the algorithm. The specification however does not teach an algorithm specifying a creative aspect of an advertisement generated by the algorithm. The specification teach generating (or "create") advertisements (also referred to as the "creative"). Claim 35 is also rejected for the same reason.

Claims 1, 2, 4, 6-21 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites each generated advertisement set including at least one different advertisement created using …. It is unclear what "at least one different advertisement" means. The claim recites plurality of advertisement generators each operable to automatically generate

an advertisement set. Since there is only one advertisement set generated, it is unclear how the generated advertisement set includes a different advertisement (different from what).

Claim 9 recites the limitation "each advertisement set being generated for the same advertiser and the same keyword". There is insufficient antecedent basis for this limitation in the claim. The claim does not recite "advertiser" or a "keyword". Claim 35 is also rejected for the same reason stated above in claim 9.

Claims 1, 9, and 35 recite "creative aspect of an advertisement". Since applicant's specification does not provide clear definition of a "creative aspect", it is unclear what is considered a creative aspect of an advertisement.

In Regard to claims 9 and 35, according to applicant's disclosure "advertisement set" includes one or more advertisement, one or more search terms and a link to an advertised item. The claim recited automatically creating a least one advertisement for each of a plurality of advertisements sets being generated using plurality of advertisement generators. If the advertisement set (which includes advertisement, search term and a link) is generated by advertisement generators, it is unclear if the automatically created advertisement is the same as the one generated by the advertisement generator (which is part of the advertisement set) or is in addition to the advertisement set. The specification also does not disclose that the advertisement set includes a bid amount. The specification teaches the advertisement manager invokes a bid calculator to calculate a bid amount for each advertisement set, but does not teach that the bid amount is part of the advertisement set generated by the algorithm.

In light to applicant's specification, Examiner's understand is that the advertisement which is part of the advertisement set is automatically created.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4, 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calabria et al. (US 2005/0137939).

Regarding claims 1 and 2, Calabria teaches an advertisement generators each use a algorithm to automatically generate an advertisement sets for advertiser and a keyword (see [0052]-[0055] [0121]); each advertisement set having a keyword and an advertisement; a fee calculator that calculates fee amounts for advertisements based on anticipated profitability of the advertisement sets (see [0013], [0019] – [0023] an advertisement submitter that sends to an advertisement placement service a request to place the advertisement along with content associated with the keyword at the fee amount of an advertisement set; and an advertisement manager that receives from the advertisement generator advertisement sets, receives from the fee calculator a fee amount for each advertisement set, and provides to the advertisement submitter the selected advertisement sets that each have an advertisement, a keyword, and a fee amount (see [0035] – [0040], [0044]- [0047], [0109]). According to applicant's disclosure advertisements are referred to as the "creative". Calabria does not teach first algorithm for identifying search terms, second algorithm for determining creative aspect of an advertisement and a third algorithm for creating a link. Examiner's interpretation of an algorithm is a set of rules used to perform a task. Therefore, it would have been obvious to one of ordinary skill in the

art at the time of the invention to know that the algorithm of Calabria would have different rules since the different tasks of identifying of a search term, determining a creative aspect and creating a link would require different rules and steps to perform the different tasks.

Regarding claims 4, 7, 8, Calabria teaches the advertisement manager selects one of the multiple advertisement sets based at least in part on determined likelihood of users selecting the advertisement when it is placed along with a content associated with the keyword; a database containing statistics relating to placements of advertisements and wherein the fee calculator determines anticipated profitability based on analysis of the statistics; wherein the statistics include average cost-per-click of an advertisement and average revenue-per-click (see [0120]-[0123],[0133]- [0147]).

Regarding claim 6, Calabria teaches multiple advertisement submitters where each advertisement submitter is associated with an advertisement placement service (see [0153]).

Claims 9-14, 16-21 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calabria et al. (US 2005/0137939) in view of Harik (US 2005/0065806 A1).

Regarding claims 9, 19, 35, Calabria teaches a plurality of advertisement sets being generated using a plurality of advertisement generators algorithm for each advertisement set, (see [0052]-[0055] [0121]); each advertisement set having a keyword and an advertisement; a fee calculator that calculates fee amounts for advertisements based on anticipated profitability of the advertisement sets (see [0013], [0019] – [0023]; specifying a bid amount for each advertisement set (abstract, [0014], [0022]); determining whether an advertisement set is currently submitted to an advertisement placement service for the keyword; submitting to the advertisement placement service a request to place the advertisements specified by the selected advertisement sets;

analyzing the effectiveness of the placed advertisement, the effectiveness of the placed advertisement being based on at least financial benefit of placing the advertisement; and subsequently selecting advertisement sets for placement of advertisements based on the analysis, so that the selected advertisement set does not conflict with an advertisement set that is currently submitted to the advertisement placement service for the keyword (see [0018], [0019], [0052]-[0054]); when an advertisement set is not currently submitted to the advertisement placement service for the keyword, selecting one of the generated advertisement sets for submission to the advertisement placement service. Calabria does not but Harik teaches automatically creating at least one advertisement, each advertisement generator determines creative aspect of at least one advertisement (see [0057], [0058], [0060]-[0067], [0080]). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Harik's ad creative generation operations in Calabria's in generating advertisement set, in order to generate online advertisements from Internet data by automatically determining all components for an advertiser, as taught in Harik's (see [0057].

Regarding claims 10-14 and 16-18, Calabria teaches wherein the bid amount is based on advertising metrics, profit, revenue, etc.; placing the advertisement with search result associated with a search term matching the keyword; placing with content associated with keyword. Calabria teaches selecting a keyword combination, providing an estimate of return on investment for the bid associated with the keyword combination analyzing; the effectiveness of the placed advertisements for each-the advertisement sets, the effectiveness of an advertisement being based on at least financial benefit of placing the advertisement; and selecting advertisement sets for

placement of advertisements based on the analysis (see [0035]-[0040], [0044]- [0047], [0052]-[0060], [0109], [0121]).

Regarding claims 20 and 21, Calabria teaches filtering generated advertisement sets based on frequency or desirability of keywords (see [0054]-[0059]).

Response to Arguments

Applicant's arguments with respect to claims 1, 2, 4, 6-14, 16-21 and 35 and have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dunham et al. (US 2003/0216930) teaches assessing and placing an advertiser's link in an optimal position on a search results list based upon a multiplicity of variables.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR
/Yehdega Retta/
Primary Examiner, Art Unit 3622